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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,242	01/19/2005	Eleanor Bernice Ridley	HP/15-22715/A/MA 2224/PCT	6482
324 7590 02/13/2009 JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591				
EXAMINER ROGERS, JAMES WILLIAM				
ART UNIT		PAPER NUMBER		
1618				
MAIL DATE		DELIVERY MODE		
02/13/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/523,242

**Applicant(s)**

RIDLEY ET AL.

**Examiner**

JAMES W. ROGERS

**Art Unit**

1618

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 11-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/11/2008 has been entered.

The amendments to the claims filed 11/03/2008 have been entered.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3,5-9 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Robinson et al. (EP 247,774 A2), for the reasons set forth in the previous office action filed 07/30/2008.

Applicant's arguments filed 11/03/2008 have been fully considered but they are not persuasive.

Applicants assert that as now amended Robinson no longer reads on applicants claimed invention, since now the claims are drawn to a process of preparing a water and/or oil based personal care composition.

The examiner respectfully disagrees. As now amended applicants claims do read on a process to make a composition, however as noted in the previous office action the composition of Robinson and the process of making a composition are both within applicant's claimed scope. Applicants seem to assert that the recitation of "personal care" before composition precludes the Robinson reference, however it is noted by the examiner that this is an intended use type of limitation for the composition, when in fact the claims are drawn to a method of making a composition. Since the process to make the composition and the composition itself are the same Robinson anticipates applicant's claims. The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. Since the prior art teaches the same method of making the composition, it would be expected to be at least capable of performing the same intended use.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al. (US 6,365,656) in view of Cockcroft et al. (WO 02/40622) in view of

Lentini et al. (US 5,665,368), for the reasons set forth in the previous office actions filed 01/11/2008 and 07/30/2008.

Applicant's arguments filed 11/03/2008 have been fully considered but they are not persuasive.

Applicants as before argue that there is a difference in the instant process and those of Green in that Green teaches reverse phase emulsion polymerization which is fundamentally different than their claimed process which is an emulsion polymerization and would lead to different polymers even if the same monomers were used.

The relevance of this assertion is unclear. Firstly the examiner notes that the claims are now drawn to a method of making a composition not a method of making a polymer, thus whether or not a polymer is formed from a reverse or a standard emulsion polymerization technique would bear no weight if the polymers are within the same scope. For the reasons set forth previously the examiner believes the polymers taught by the combination of references above are within applicants claimed scope. Secondly as noted by the examiner previously applicants claimed emulsion polymerization technique involves combining monomers I and II in an aqueous phase which is then mixed with an oil phase and polymerized. Green specifically discloses at column 7 lines 9-27 that the reverse phase emulsion is prepared by adding one **aqueous** ethylenically unsaturated monomer into a hydrophobic liquid with sufficient agitation to form a stable emulsion. Thus the procedure of Green teaches the same technique claimed by applicants in that it adds an aqueous solution containing the monomers to a hydrophobic phase which forms an emulsion. Furthermore Green specifically recites

that the monomer blend must be water soluble and the hydrophobic liquid must have substantially no solvating effect on the polymer. See col 5 lin 4-17. Applicants claims at least as currently amended do not preclude the method of Green. Lastly it is noted by the examiner that reverse phase polymerization is a form of emulsion polymerization, essentially it is a species within the genus of emulsion polymerization. The claims do not preclude a reverse phase emulsion polymerization since the phrase "emulsion polymerization" encompasses reverse phase emulsion polymerization. As evidence the examiner submits Principles of Polymerization, 3<sup>rd</sup> ed., John Wiley and Sons, Inc., Odian pp.352-353, which indicates that reverse phase emulsion polymerization is a form of emulsion polymerization.

Claims 1-9 and 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green et al. (US 6,365,656) in view of Robinson et al. (EP 247,774 A2), for the reasons set forth in the previous office action filed 07/30/2008.

Applicant's arguments filed 11/03/2008 have been fully considered but they are not persuasive.

Applicants assert that Robinson includes comparative examples that used acrylamide to make the cationic copolymers; thus applicants believe Robinson does not read on their invention because acrylamide is excluded from the claims. Applicants then assert that Robinson teaches polymers that are similar to their own and states they have inferior properties and thus directs one away from their own claimed invention.

Lastly applicants seem to assert that Green and Robinson are directed to divergent subject matter and thus would not be obvious to combine.

The examiner respectfully disagrees. Regarding Robinson, the examples within Robinson were given solely for the purpose of illustration and were not to be construed as being limiting to their invention since many variations are possible without departing from the spirit and scope of the invention. Clearly Robinson teaches water-in-oil emulsions containing cationic water-soluble copolymers comprised of a nonionic monomers (including n-methylmethacrylamide) and cationic monomers (including dimethylaminoethylmethacrylate DMAE(M)A), both of these monomers are within applicants claimed scope for the non-ionic and cationic monomers respectfully. Regarding applicants assertion that the two references are too divergent to combine, it is noted by the examiner that Robinson was only used as a secondary reference for its disclosure that the exact type of copolymer claimed by applicants was already well known at the time of the invention. The polymers of Robinson only varied from Green very slightly in that the nonionic monomers of Green included acrylamide but not the specific acrylamide monomers claimed, which is why the reference was combined with Robinson who does disclose nonionic acrylamide monomers within applicants claimed scope. Thus the examiner concluded that since the references were at least related as compositions containing cationic polymers comprised of a non-ionic acrylamide and cationic quaternary ammoniums they would be obvious for one of ordinary skill in the art to combine and have a reasonable expectation of success.

### **Conclusion**

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 9:30-6:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/

Supervisory Patent Examiner, Art Unit 1618